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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,989	09/30/2003	Frederick Forbes Vannan	FFV-002	5234

7590 10/31/2005

Frederick F. Vannan
8509 Foxglove Ave. N.W.
Clinton, OH 44216

EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,989

Applicant(s)

VANNAN, FREDERICK FORBES

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's amendment filed May 3, 2005 has newly presented claims to a plurality of patentably distinct inventions and species (see the note in paragraph 2 of the Office action mailed March 21, 2005). A restriction and election of species requirement follows.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 12-14, drawn to a method of manufacturing a reinforced liquid elastomer tire including holding the reinforcement cords, wires and/or cables in position within a tire molding cavity while liquid elastomer is poured or injected around it and subsequently solidifies, classified in class 156, subclass 112.
 - II. Claims 15-21 and 24-30, drawn to a liquid elastomer tire made by a method including holding the reinforcement cords, wires and/or cables in position within a tire molding cavity while liquid elastomer is poured or injected around it and subsequently solidifies, classified in class 152, subclass 151.
 - III. Claims 22 and 23, drawn to an apparatus for performing a method of manufacturing a reinforced liquid elastomer tire including holding the reinforcement cords, wires and/or cables in position within a tire molding cavity while liquid elastomer is poured or injected around it and subsequently solidifies, classified in class 156, subclass 404.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by

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another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the reinforcement is coated with liquid elastomer to surround each reinforcement element with the liquid elastomer and then the coated reinforcement is laid loosely at the bottom of the molding cavity without presolidification of the liquid elastomer (and thus not “held” in position within the tire molding cavity as required by the method). Note that the product-by-process tire claims are not limited to the recited steps but only to the structure implied by the steps, and that the method limitation “precisely positioned” in the tire claims does require any particular positioning of the reinforcement with respect to the finished tire and therefore does not further limit the tire structure required by the tire claims (MPEP 2113).

4. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one in which the reinforcement elements are held together to form the reinforcement assembly by other than liquid elastomer (for example thermoplastic or thermosetting resin). Note that in apparatus claims the apparatus is not necessarily limited to the material intended to be worked upon, and in these apparatus claims the intended liquid elastomer material does not imply any further apparatus structure which would exclude other flowable materials such as thermoplastic or thermosetting resins (MPEP 2115).

5. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as

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claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as one in which the reinforcement is coated with liquid elastomer to surround each reinforcement element with the liquid elastomer using a coating bath and then the coated reinforcement is laid loosely at the bottom of the molding cavity. Note that the product-by-process tire claims are not limited to the recited steps but only to the structure implied by the steps, and that the method limitation "precisely positioned" in the tire claims does require any particular positioning of the reinforcement with respect to the finished tire and therefore does not further limit the tire structure required by the tire claims (MPEP 2113).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. **Once allowable subject matter is identified in the elected invention, the examiner will consider rejoining claims directed to the non-elected inventions which incorporate or otherwise include all of the limitations of the allowable subject matter.**

8. This application contains claims directed to the following patentably distinct species of the claimed invention: a liquid elastomer tire made by the method and apparatus according to the embodiment of either Figures 1-5F (multiple stage molding including premolding the components of the reinforcement assembly outside of the tire mold) or Figures 6A-8 (single stage molding inside the tire mold)(specification p. 5 line 11 - p. 12 line 17).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Currently, claim 12 is generic in the method claims, claim 15 is generic in the tire claims, and no apparatus claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. A telephone call was made to Frederick Vannan on October 27, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

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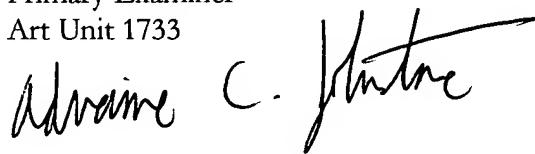
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne Johnstone

October 27, 2005

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

A handwritten signature in black ink, appearing to read "Adrienne C. Johnstone", with a long horizontal flourish extending to the right.